

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT  
OF THE TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re The Chase Manhattan Corporation

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Serial No. 75/804,432

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Randi S. Miller of Darby & Darby, PC for The Chase  
Manhattan Corporation.

Jennifer S. Chicoski, Trademark Examining Attorney, Law  
Office 115 (Tomas V. Vlcek, Managing Attorney).

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Before Simms, Bottorff and Holtzman, Administrative  
Trademark Judges.

Opinion by Simms, Administrative Trademark Judge:

The Chase Manhattan Corporation (applicant) has  
appealed from the final refusal of the Trademark Examining  
Attorney to register the mark I-VAULT! for electronic  
storage and retrieval of documents, text, images, and data  
in the fields of banking and finance provided via a global  
computer network.<sup>1</sup>

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<sup>1</sup> Application Serial No. 75/804,432, filed September 21, 1999, based upon  
an allegation of use in commerce since August 1, 1999. On May 7, 2001,  
in view of a refusal to register this mark on the basis of mere

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 1,944,738, issued December 26, 1995, Sections 8 and 15 accepted and acknowledged, respectively, for the mark shown below:



for remote computer data backup services, namely providing storage facilities for computer data backup, archiving and retrieval over communication lines, and providing the computer software and hardware for such access. In the registration, it is indicated that the word "VAULT" is disclaimed and that the mark is lined for the color blue. Applicant and the Examining Attorney have submitted briefs and an oral hearing was held.

It is the Examining Attorney's position that the respective marks are similar in sound, appearance and commercial impression. More particularly, the Examining Attorney argues that both marks contain a vowel followed by

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descriptiveness under Section 2(e)(1), 15 USC §1052(e)(1), applicant amended this application to seek registration on the Supplemental Register.

the word "VAULT," and that that minor difference as well as the presence of a hyphen and exclamation point in applicant's mark are insufficient to distinguish the respective marks. Concerning the meaning or commercial impressions of the marks, the Examining Attorney argues that "e" and "I" both mean "electronically via the Internet," because of the now well-accepted significance of the letter "e" as meaning the providing of something electronically over a computer network and the letter "I" being an abbreviation for the Internet. In this regard, the Examining Attorney has submitted evidence concerning the significance of the letter "I" in such phrases as "I-commerce," "I-business" or "iBusiness."<sup>2</sup> The Examining Attorney also notes that, according to applicant's description of services, applicant is providing its services over the Internet. Concerning any design aspects of the respective marks, the Examining Attorney argues that the words predominate and would be used in calling for respective services.

With respect to the term "vault," which predominates in both marks, the Examining Attorney has submitted an

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<sup>2</sup> The Examining Attorney also refers the Board to the case of *In re Zanova, Inc.*, 59 USPQ2d 1300 (TTAB 2001), where, in connection with its holding that the term ITOOL was merely descriptive of various computer services and software, the Board stated that "I" in the mark signified the Internet.

online dictionary definition of "data vaulting" meaning "The process of sending data off-site, where it can be protected from hardware failure, theft, and other threats." Although the Examining Attorney concedes that the term "VAULT" has some significance in the respective marks and may be a "weak" term, the Examining Attorney argues that the registered mark is nevertheless entitled to protection.

Concerning the services, the Examining Attorney argues that they are closely related services involving the transmission of documents and images over communication lines, the storage of such data and the retrieval thereof. More particularly, although registrant's services also serve a security or backup function, they include the archiving or storage and retrieval of data. The Examining Attorney contends that applicant, by providing storage facilities for data, is also providing a backup for that data, as is registrant. The Examining Attorney argues that applicant's storage and retrieval services and registrant's storage and retrieval services must be considered as being offered in similar channels of trade, in the absence of any limitation in the registrant's identification, which is unrestricted as to scope. The Examining Attorney also asks the Board to resolve any doubt in favor of the registrant.

Applicant, on the other hand, maintains that the differences in the marks, the weakness of registrant's mark as well as the differences of the services, are sufficient to avoid any likelihood of confusion. Applicant argues that the registered mark eVAULT is highly suggestive (if not descriptive) of the method of sending data off-site where it can be protected. Applicant points to the disclaimer of the word "VAULT" in the registration as evidence of the weakness of the only common element in the marks. Applicant has also made of record various third-party registrations containing the word "VAULT," showing the descriptiveness of this term and its weakness in connection with data storage and retrieval services. Applicant also notes that the "e" in the registered mark is commonly understood as an abbreviation for "electronic." Because of the weakness of the registered mark, the addition of other matter by applicant, such as the "I," the hyphen and the exclamation point, is sufficient to avoid likelihood of confusion, according to applicant. In fact, applicant maintains that the Examining Attorney should only have compared the design elements of the marks. As to the meanings or commercial impressions, applicant argues that the registered mark might signify "electronic vault" whereas the "I" in its mark refers to and is suggestive of

"image" or "imaging," resulting in the suggestive meaning of state-of-the-art (in view of the exclamation point) electronic imaging technology.

Turning to the services, applicant argues that there is no *per se* rule relating to the finding of likelihood of confusion where the goods and services involve computer hardware or software. Applicant argues that registrant's electronic backup storage services fulfill a security function, whereas applicant's services allowing instant access to documents increase the efficiency and speed in the workplace. Applicant maintains that the only similarity in the respective services is the retrieval capability but that, whereas retrieval is central to applicant's services, registrant's services involve retrieval in the rare event a document is needed. Applicant also argues that one can infer from the very nature of the respective services that the purchasers thereof will be sophisticated and will have an ongoing relationship with the service provider. Applicant states that the potential customers of the services are business owners, managers, and technical experts who are likely to contract for the services after careful consideration. Finally, applicant's attorney notes that there have been no

instances of actual confusion for over two and one-half years. Applicant's brief, 15.

In response to the latter points, the Examining Attorney argues that there is no evidence of record concerning the sophistication of the purchasers or concerning the lack of actual confusion.

Upon careful consideration of this record and the arguments of the attorneys, we conclude that applicant's mark I-VAULT! for its electronic storage and retrieval services in the fields of banking and finance so resembles the registered mark eVAULT for computer data backup services involving the storage and retrieval of documents that confusion is likely.

First, concerning the marks, while we agree with applicant that the marks at issue are distinguishable on the basis of a side-by-side comparison, such is not the proper test to be used in determining the issue of likelihood of confusion in the marketplace inasmuch as it is not the ordinary way that relevant customers are likely to be exposed to the marks. Instead, it is the similarity of the general overall commercial impressions engendered by the marks which must determine, due to the fallibility of memory and lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is,

therefore, on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981). While we cannot agree with the Examining Attorney that these marks are likely to be pronounced identically, we do believe that they are similar in pronunciation, as well as in appearance, both beginning with a vowel and being dominated by the word "VAULT." Further, disclaimed matter cannot be ignored.

The Board correctly held that the filing of a disclaimer with the Patent and Trademark Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion. The marks must be considered in the way in which they are perceived by the relevant public. [Applicant's] argument that the only consideration is the "design form" of the words "Right-A-Way," omitting the words "right-a-way" because they were disclaimed, was correctly rejected by the Board.

*In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-89 (Fed. Cir. 1993).

More significantly, we believe that both marks have substantially similar meanings or commercial impressions, as the Examining Attorney has argued. Applicant's contention that the "I" in its mark will be interpreted as a reference to "image" or "imaging" is not persuasive. We have carefully examined applicant's specimens of record and



we do not believe that potential purchasers will so construe the "I" in applicant's mark.<sup>3</sup>

Furthermore, applicant's storage and retrieval services in the fields of banking and finance are closely related to registrant's backup storage and retrieval services. In this regard, we must compare the respective descriptions as listed in the application and the registration. "Likelihood of confusion must be determined based on an analysis of the mark applied to the ... services recited in applicant's application vis-à-vis the ... services recited in [a] ... registration, rather than what the evidence shows the ... services to be." *In re Dixie*

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<sup>3</sup> For example, while the brochure cover states "Introducing *i-VAULT!*<sup>TM</sup> Harnessing state-of-the-art electronic imaging for rapid retrieval of documents and data," the first several references to the I-VAULT service in applicant's specimen do not clearly reinforce any association with "imaging": **"State-Of-The-Art Archive At An Affordable Cost** *i-VAULT!*<sup>TM</sup> is designed to provide you the benefits of state-of-the-art archive storage and retrieval without the high initial costs of investing in archive equipment and programming, and the continuing expense of archive system maintenance and upgrades. The *i-VAULT!*<sup>TM</sup> service may also limit your need to make heavy additional investments to replace a costly archive system that rapid advances in technology have made obsolete... A major advantage of *i-VAULT!*<sup>TM</sup> is that it is designed to cross-reference documents. Thus, *i-VAULT!*<sup>TM</sup> has the capability to index in the archive by name, number, subject, date or any other designated field up to a maximum of 30 fields. This helps an *i-VAULT!*<sup>TM</sup> customer implement a rapid search across large quantities of text and data to identify and retrieve... *i-VAULT!*<sup>TM</sup> is designed to be more efficient than physical storage of paper, microfilm and microfiche... In this rapidly evolving environment, Chase has made an enormous investment of time and money in developing an image-based platform. *i-VAULT!*<sup>TM</sup> is one result of this initiative—one that exemplifies a leadership role in imaging and efficient workflow technology that is acknowledged by respected industry experts and publications." Suffice it to say that, while in at least two instances the word "image" or "imaging" is used near the mark I-VAULT!, there is no persuasive evidence that the relevant consumers will perceive the "I" in applicant's mark as a reference to "image" or "imaging."

Serial No. 75/804,432

*Restaurants*, 105 F.3d 1405, 41 USPQ 1531, 1534 (Fed. Cir. 1997)(punctuation in original), quoting, *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1816 (Fed. Cir. 1987). See also *Paula Payne Products Co. v. Johnson Publishing Co.*, 473 FF.2d 901, 177 USPQ 76 (CCPA 1973); and *In re Opus One Inc.*, 60 USPQ2d 1812, 1817 (TTAB 2001). While applicant's fields have been restricted to banking and finance, registrant's storage and retrieval services are not so restricted and may be offered in those fields of endeavor.

Concerning the conditions of purchase, this factor seems to weigh in applicant's favor. That is, potential purchasers of the respective storage and retrieval services would appear to be business customers who may exercise some degree of care in the purchasing decision. However, we do not believe that this factor precludes the likelihood of confusion, in view of the similarities of the marks and services.

We conclude that purchasers, aware of registrant's eVAULT backup storage and retrieval services who then encounter applicant's I-VAULT! storage and retrieval services, even if they recognize the specific differences in the marks--the lower case "e" vs. capital "I," the hyphen, the exclamation point, blue display of the word

Serial No. 75/804,432

"VAULT" in registrant's mark--are likely to believe that all of these services come from the same source. Any doubts we might have as to whether a likelihood of confusion exists must be resolved against applicant and in favor of registrant. *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Decision: The refusal of registration is affirmed.